

## **REMARKS**

### **A. RESTRICTION**

The Examiner maintains that the present application contains claims directed to the following patentably distinct inventions:

- |           |  |
|-----------|--|
| Group I.  | Claims 1-12, drawn to a device for molten metal dispensing, classified in class 266, subclass 236; |
| Group II. | Claims 13-20, drawn to a coupling, classified in class 403, subclass 342;                          |
| Group III | Claims 21-26, drawn to a rotary degasser, classified in class 222, subclass 603;                   |
| Group IV. | Claims 27-29, drawn to a rotary shaft, classified in class 464, subclass 179; and                  |
| Group V.  | Claims 30-37, drawn to a molten metal device, classified in class 266, subclass 235.               |

Applicant notes that claims 36 and 37 depend on claim 12, which depends ultimately on claim 1. Therefore, Applicant respectfully requests that claims 36 and 37 be included in Group I.

#### **1. Election with Traverse**

Applicant hereby elects the inventions of Group II, pertaining to claims 13-20 with traverse, and asserts that Groups I, III, IV, and V should also be prosecuted in this Application. Applicant respectfully requests reconsideration and withdrawal of the restriction requirement.

#### **2. Argument in Support of Restriction Requirement Traversal**

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (a) the inventions must be independent or distinct as claimed; and
- (b) there must be a serious burden on the Examiner if restriction is required.

MPEP § 803.01.

## **I. Combination and Subcombination**

Applicant submits that the Examiner has not established a proper basis for restrictions in this case with respect to Groups I, II, III, IV, and V.

The Examiner asserts that inventions (I, III and IV) and (II and V) are related as combination and subcombination. The Examiner contends that the combination as claimed does not require the particulars of the subcombinations as claimed because the devices of Groups I, III and IV do not require the specific structures recited in the shafts and couplings of Groups II and V. The Examiner further asserts that the subcombinations have separate utility such as use on other prior art mixing or stirring applications.

The inventions in the relationship of combination and subcombination are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) the subcombination can be shown to have utility by itself or in another materially different combination. MPEP §806.05(c), emphasis added.

The claims of the device of Group I and the coupling of Group II, claim 13, both set forth the same limitation of a coupling comprising (a) a first coupling member for connecting to the second end of the motor shaft; and (b) a second coupling member for connecting to the first end of the rotor shaft. The combination of Group I therefore requires the particulars of Group II for patentability.

Further, the claims of the device of Group III and the coupling Group II, claims 14-20, both set forth details of the subcombination. The combination of Group III therefore requires the particulars of Group IV for patentability.

Where the inventions are not distinct a requirement for restriction must not be made or maintained, even if the subcombination has separate utility. MPEP §806.05(c).

Finally, even assuming the Examiner had been correct, the Examiner has not cited any art or facts to show why the search of these claims in a single application would be a serious burden on the Examiner. Applicant therefore respectfully requests that the restriction requirement be withdrawn, and the claims of Groups I, II and III be examined in a single application.

The Examiner further alleges that the subcombinations of Groups II and V have separate utility outside of the claimed combinations of Groups I, III and IV. Applicant respectfully disagrees. First, Applicant notes that Group IV claims a rotor shaft and not a combination. The Examiner describes such uses as in “other prior art mixing or stirring applications.” Applicant does not know what kind of “prior art” mixing and stirring applications could utilize the subcombinations of the type claimed herein, and kindly requests the Examiner to elucidate. The burden is on the Examiner to provide an example of how the subcombinations have utility other than in a molten metal device. It is respectfully submitted that the Examiner has not met this burden. Finally, even assuming that the Examiner had been correct, the Examiner has not cited any art or facts to show why the search of these claims in a single application would be a serious burden on the Examiner. Applicant therefore respectfully requests that the restriction requirement be withdrawn, and the claims of Groups I –V be examined in this application.

## **II. Inventions I, III and IV are Unrelated**

The Examiner alleges that Inventions I, III and IV are unrelated. Inventions as claimed are independent if there is no disclosed relationship between the inventions, that is, if they are unconnected in design, operation and effect and if there would be a serious burden on the Examiner if restriction is not required. MPEP §806.06. The Examiner asserts that the different inventions are not useable together and have different modes of operation in that the coupling arrangements of each of the above groups are structurally different and operate in different manners. Applicant respectfully disagrees. The claimed inventions are for use in molten metal devices and applications. Thus, there is a relationship between them. The rotor shaft of Group IV could be used in the device of Group I, which comprises a rotor shaft. Further, claims 5 – 7 of Group I teach that the device of Group I may further comprise a gas-release device. The invention of Group III teaches a gas release device that could be used with the device of Group I. Thus, the inventions of Groups I, III and IV are related. It is respectfully submitted that the Examiner has not met the burden of showing that the inventions are unconnected in design, operation and effect. Finally, even assuming the Examiner had been correct, the Examiner has not cited any art or facts to show why the search of these claims in a single application would be a serious burden on the Examiner.

Consequently, the Examiner has not established that the inventions are unrelated or that there is a serious burden of examining the alleged inventions of Groups I, III and V as required by MPEP § 803. The claims of Groups I, III and V should therefore be examined in this application.

### **CONCLUSION**

Applicant respectfully requests the Examiner to reconsider and withdraw the Restriction Requirement because the relationship between the respective inventions establishes that there is no serious burden of examining all the claims in a single application. If there are any issues the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Applicant hereby petitions for any extension of time that may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to **Deposit Account No. 19-3878**.

Respectfully submitted,

January 30, 2006

Date

By

  
David E. Rogers

Reg. No. 38,287

SQUIRE, SANDERS & DEMPSEY, LLP.

Two Renaissance Square

40 North Central Ave., Suite 2700

Phoenix, Arizona 85004

Telephone: (602) 528-4122

Facsimile: (602) 253-8129

PHOENIX/347672.1